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SUTHERLAND II			EXAMINER	
SUTHERLAND, ASBILL & BRENNAN, LLC			ANDERSON, JOHN A	
999 PEACHTREE STREET				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/631,970

**Applicant(s)**

HAMILTON ET AL.

**Examiner**

JOHN A. ANDERSON

**Art Unit**

3696

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
- Paper No(s)/Mail Date 12/27/2007;12/31/2007;02/24/2004
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_



**DETAILED ACTION**

***Information Disclosure Statement***

1. The information disclosure statement dated 12//27/2007 ;12/31/2007 and 02/24/2004 have been considered.

***Response to Amendment***

2. Claims 1-22 have been amended. Claims 23-27 have been added. Claims 1-27 are pending in this Office Action.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:  
A person shall be entitled to a patent unless –  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
4. Claims 1-3,6-14,17-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Ganesan et al (PGPUB US: 2002/0087468).
5. As regards claims 1,12 and 23 , Ganesan et al discloses a method for making a payment to a payee on behalf of a payor, comprising:

- receiving a payment request for a payment service provider to pay a payee on behalf of a payor;[0007]
  - determining a plurality of risk reduction techniques available for fulfilling the received payment request based at least in part on information included in the received payment request;[0011]
  - selecting one of the available risk reduction techniques to be used when processing the payment request based on at least one predetermined factor associated with each of the plurality of risk reduction techniques; [0014]
  - processing the payment request using effecting payment in accordance with the selected risk reduction technique. [0016]
6. As regards claims 2 and 13 , Ganesan et al discloses wherein each of the plurality of risk reduction techniques reduces a risk of financial loss to the payment service provider in processing the payment request on behalf of the payor. [0019]
7. As regards claims 3 and 14 , Ganesan et al discloses wherein the plurality of risk reduction techniques includes at least one of i) determining, prior to directing funds to the payee in association with processing the payment request, that payor funds are available, ii) determining, prior to directing funds to the payee in association with processing the payment request, that an entity is available from which to collect funds if funds cannot be collected from the payor in association

with processing the payment request, iii) determining whether payment to the payee will be drawn on a deposit account associated with the payor, or drawn on a deposit account associated with an entity other than the payor, and iv) directing funds to the payee a predetermined period of time subsequent to initiating an electronic debiting of a deposit account associated with the payor. [0011]

8. As regards claims 6 and 17 , Ganesan et al discloses wherein the selected risk reduction technique is the determining whether payment to the payee will be drawn on a deposit account associated with the payor, or drawn on a deposit account associated with an entity other than the payor, and further comprising:
- determining at least one of i) if a monetary amount of the payment request is less than a predetermined first threshold, ii) if a total monetary amount of payments completed on behalf of the payor within a first predetermined time period is less than a predetermined second threshold, and iii) if a volume of payments completed on behalf of the payor within a second predetermined time period is less than a predetermined third threshold;[0024]
  - wherein, if it is determined that the monetary amount is less than the first threshold, that the total monetary amount is less than the second threshold, or that the volume is less than the third threshold, processing the payment request

includes issuing one of a check or an electronic funds transfer to the payee drawn on a deposit account associated with an entity other than the payor;  
[0091]

- wherein, if it is determined that the monetary amount is not less than the first threshold, that the total monetary amount is not less than the second threshold, or that the volume is not less than the third threshold, processing the payment request includes issuing a draft to the payee drawn on the payor deposit account.  
[0097]

9. As regards claims 7 and 18, Ganesan et al discloses, wherein the determination of each of the plurality of risk reduction techniques is based upon at least one of i) the identity of the payor, ii) the identity of the payee, iii) the identity of a financial institution at which the payor maintains a deposit account, iv) the identity of a consumer service provider with which the payor is associated, and v) a type of payment service offered by the payment service provider utilized by the payor.[0020]
10. As regards claims 8 and 19, Ganesan et al discloses, wherein each of the plurality of risk reduction techniques is associated with a level of protection against financial loss to the payment service provider for processing a payment request, and wherein selecting one of the available risk reduction techniques to be used when processing the payment request based on at least one

predetermined factor associated with each of the plurality of risk reduction techniques includes selecting the risk reduction technique that provides a highest level of protection against financial loss to the payment service provider among the plurality of risk reduction techniques available for fulfilling the received payment request.[0075]

11. As regards claims 9 and 20 , Ganesan et al discloses wherein each of the plurality of risk reduction techniques is associated with a cost of processing a payment request, and wherein selecting one of the available risk reduction techniques to be used when processing the payment request based on at least one predetermined factor associated with each of the plurality of risk reduction techniques includes selecting the risk reduction technique that is associated with a least cost of processing the payment request among the plurality of risk reduction techniques for fulfilling the received payment request [0010];
12. As regards claims 10 and 21 , Ganesan et al discloses wherein each of the plurality of risk reduction techniques is associated with a time period for processing a payment request, and wherein selecting one of the available risk reduction techniques to be used when processing the payment request based on at least one predetermined factor associated with each of the plurality of risk reduction techniques includes selecting the risk reduction technique that is



techniques associated with a shortest time period to complete payment to the payee among the plurality of risk reduction techniques for fulfilling the received payment request, [0097]

13. As regards claims 11 and 22, Ganesan et al discloses wherein each of the plurality of risk reduction techniques is associated with a priority wherein selecting one of the available risk reduction techniques to be used when processing the payment request based on at least one predetermined factor associated with each of the plurality of risk reduction techniques includes selecting the risk reduction technique that is associated with the highest priority among the plurality of risk reduction techniques for fulfilling the received payment request. [0080]-

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

15. Claims 4, 5, 15, 16, 24, 25, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ganesan et al (PGPUB US: 2002/0087468) and further in view of Hilt J et al (US Patent No.: 6,032,133).
16. As regards claims 4 and 15, Ganesan et al discloses wherein the plurality of risk reduction techniques includes at least one of i) determining, prior to directing funds to the payee in association with processing the payment request, that payor funds are available, ii) determining, prior to directing funds to the payee in association with processing the payment request, that an entity is available from which to collect funds if funds cannot be collected from the payor in association with processing the payment request, iii) determining whether payment to the payee will be drawn on a deposit account associated with the payor, or drawn on a deposit account associated with an entity other than the payor, and iv) directing funds to the payee a predetermined period of time subsequent to initiating an electronic debiting of a deposit account associated with the payor. [0011]

Ganesan does not disclose wherein the selected risk reduction technique is the determining that payor funds are available, and further comprising:

- receiving, from a financial institution at which at least one of a payor deposit account or a service provider deposit account is maintained, one of (i) confirmation that the payor deposit account has been successfully debited or (ii) confirmation that the service provider account has been successfully credited.
- wherein the payment to the payee, drawn on the service provider account, is processed responsive to receiving the one of (i) confirmation that the payor deposit account has been successfully debited or (ii) confirmation that the service provider account has been successfully credited

Hilt discloses wherein the selected risk reduction technique is the determining that payor funds are available, and further comprising:

- receiving, from a financial institution at which at least one of a payor deposit account or a service provider deposit account is maintained, one of (i) confirmation that the payor deposit account has been successfully debited or (ii) confirmation that the service provider account has been successfully credited,  
[column 8 lines 40-50]
- wherein the payment to the payee, drawn on the service provider account, is processed responsive to receiving the one of (i) confirmation that the payor deposit account has been successfully debited or (ii) confirmation that the service provider account has been successfully credited [column 9 lines 31-41]

It would have been obvious for a person of ordinary skill in the art at the time of the invention was made to use Hilt in the device of Ganesan. The motivation

would have been to be reassured that the transaction was successfully completed.

17. As regards claims 5 and 16 , Ganesan et al discloses wherein the plurality of risk reduction techniques includes at least one of i) determining, prior to directing funds to the payee in association with processing the payment request, that payor funds are available, ii) determining, prior to directing funds to the payee in association with -processing the payment request, that an entity is available from which to collect funds if funds cannot be collected from the payor in association with processing the payment request, iii) determining whether payment to the payee will be drawn on a deposit account associated with the payor, or drawn on a deposit account associated with an entity other than the payor, and iv) directing funds to the payee a predetermined period of time subsequent to initiating an electronic debiting of a deposit account associated with the payor. [0011]

Ganesan does not disclose wherein the selected risk reduction technique is the determining that an entity is available from which to collect funds if funds cannot

be collected from the payor in association with processing the payment request, and further comprising:

- identifying the entity from which to collect funds
- wherein the payment request is processed responsive to the identification of the entity;
- wherein the payment request is drawn on a deposit account associated with the payment service provider;
- wherein the identified entity is one of the payee and a consumer service provider with which the payor is associated.

Hilt discloses wherein the selected risk reduction technique is the determining that an entity is available from which to collect funds if funds cannot be collected from the payor in association with processing the payment request, and further comprising:

- identifying the entity from which to collect funds [column 2 lines 64-10]
- wherein the payment request is processed responsive to the identification of the entity; [column 3 lines 45-55]
- wherein the payment request is drawn on a deposit account associated with the payment service provider; [column 10 lines 6-13]
- wherein the identified entity is one of the payee and a consumer service provider with which the payor is associated. [column 10 lines 19-25]

It would have been obvious for a person of ordinary skill in the art at the time of the invention was made to use Hilt in the device of Ganesan . The motivation would have been to prevent fraudulent transactions that will result in financial losses.

18. As regards claims 24 and 26 , Ganesan et al discloses receiving, from a financial institution at which at least one of a payor deposit account or a service provider deposit account is maintained, one of (i) confirmation that the payor deposit account has been successfully debited or (ii) confirmation that the service provider account has been successfully credited. [column 5 lines 35-45]

Ganesan et al does not disclose transmitting a confirmation request to the financial institution, wherein the one of (i) confirmation that the payor deposit account has been successfully debited or (ii) confirmation that the service provider account has been successfully credited is received responsive to transmitting the confirmation request.

Hilt discloses transmitting a confirmation request to the financial institution, wherein the one of (i) confirmation that the payor deposit account has been successfully debited or (ii) confirmation that the service provider account has been successfully credited is received responsive to transmitting the confirmation request. [0019 and 0059]

It would have been obvious for a person of ordinary skill in the art at the time of the invention was made to use Hilt in the device of Ganesan . The motivation would have been to reconcile the account after the transaction has been completed.

19. As regards claims 25 and 27, Ganesan et al discloses wherein the payment to the payee, drawn on the service provider account, is processed responsive to receiving the one of (i) confirmation that the payor deposit account has been successfully debited or (ii) confirmation that the service provider account has been successfully credited [column 22 lines 16-26]

Ganesan et al does not disclose transmitting an electronic funds transfer file to debit the payor deposit account and to credit the service provider account.

Hilt discloses transmitting an electronic funds transfer file to debit the payor deposit account and to credit the service provider account. [0019]

It would have been obvious for a person of ordinary skill in the art at the time of the invention was made to use Hilt in the device of Ganesan. The motivation would have been to effect the transaction such that both accounts belonging to the payor and payee reflect the most recent transaction.

***Response to Arguments***

20. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **JOHN A. ANDERSON** whose telephone number



is (571)270-3327. The examiner can normally be reached on Monday through Friday 8:00 to 5:00 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John A Anderson/  
Examiner, Art Unit 3696

John A Anderson  
Examiner  
Art Unit 3696

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/J. A. A./

Examiner, Art Unit 3696 10/07/2008

/Daniel S Felten/

Primary Examiner, Art Unit 3696